II. THE ISSUE IS IMPORTANT.

A. The Issue Is Important to Maintain the National Uniformity Congress Intended.

Respondents do not question the inherent importance of a longstanding conflict between the circuits and this Court, or of maintaining uniformity in interpreting "employer." But their view tolerates an even worse inconsistency, within a single statute. Examples are circular definitions such as Darden addressed. Only an oracle could demystify a definition of "employee" equating it with "any individual employed by an employer," where "employee" has a narrow meaning excluding commissioning relationships and "employer" has the opposite meaning.

B. The Issue Is Important Because of Its Impact on Copyright Ownership.[4]

Pet. at 5 & 16 cited the reliance interests of persons divested of copyright as Lin-Brook Builders Hardware's sudden inversion of work for hire law took hold. Respondents do not contend that the current case turns on its facts and will affect few others. To the contrary, Br. Opp'n at 20-21 points to the reliance interests of those invested with copyright under Lin-Brook Builders Hardware and its progeny. Br. Opp'n at

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[4] Br. Opp'n at 15-17 misreads the Petition as urging an economic policy favoring the pre-Lin-Brook Builders Hardware doctrine. Rather, Pet. at 21-22 contended that the Ninth Circuit improperly relied on policy, rather than statutory language, in devising and later questioning its "instance and expense" test. Pet. at 22 agreed with Br. Opp'n at 18-20 that modification of work for hire legislation is a matter for Congress.

21 labels this the "real" reliance class, next to which the interests referred to in the Petition "pale in comparison."

Respondents' point does not lessen the importance of the issue presented, but enlarges it. By specifying a second reliance class respondents add to those identified already as having a stake in the issue. And there is no reason to believe that one group is less "real" than the other.[5]

C. The Ninth Circuit's Doctrine Is Constitutionally Questionable.

To cast doubt on the issue's constitutional importance, Br. Opp'n at 17 engages in further hyperbole: "No court anywhere has ever cast doubt on the constitutionality of the 1909 Act work-for-hire provision as it has long been construed." This is falsified not only by Judge Friendly's dissent in Scherr v. Universal Match Corp., 417 F.2d 497,

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[5] Br. Opp'n at 3 opines that the Ninth Circuit's doctrine affects "a rapidly-diminishing proportion of copyrighted works, i.e., those still copyrighted under the 1909 Act." But construction of "employer" has implications both for initial copyright and renewal. See Pet. at 6-7 n.1. The potential duration of protection for works whose copyrights were secured before 1978 is 95 years (the 28-year initial term plus the 67-year renewal term). See Pet. at 6. The only 1909 Act works which are in the public domain through lapse of that term are those whose copyrights were secured before 1911, a trivial "proportion." Further, respondents make no mention of the commercial reality that in this digital age, with its proliferation of unanticipated commercial uses of copyrighted (and public domain) works, copyright status vel non is of greater economic significance than in decades past. Finally, the profusion of cases in the lower Courts refutes the notion of a "rapidly-diminishing" problem.

502 (2d Cir. 1969), but also, e.g., by Brunswick Beacon, Inc. v. Schock-Hopchas Publishing Co., 810 F.2d 410, 412 (4th Cir. 1987), and Schmid Brothers, Inc. v. W. Goebel Porzellenfabrik KG., 589 F.Supp. 497, 503 (E.D.N.Y. 1984).

Br. Opp'n at 17-18 then acknowledges the constitutional problem, and endorses Judge Friendly's resolution: The work for hire doctrine passes muster when a contractor assigns his copyright to a hiring party. This constitutionally-mandated limitation, however, is precisely what Dastar urges. The assignment from Eisenhower to Doubleday necessary to validate work for hire status was ineffective in conveying renewal rights because of Eisenhower's death. Respondents concede not just the constitutional difficulty, but that the "instance and expense" test is incompatible with its solution.

Respectfully submitted,

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No. 05-1259

In the
Supreme Court of the United States

Dastar Corporation,
Petitioner,
v.
Random House Inc, Twentieth Century Fox Film Corporation, SFM Entertainment, LLC and New Line Home Video Inc.,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals of the Ninth Circuit

Brief of *Amici* Malla Pollack and Other Legal Scholars In Support of Dastar Corporation's Petition for a Writ of Certiorari

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Interest of the *Amici Curie*

The *amici* are legal scholars specializing in copyright and related subjects. None of *amici* has any financial interest in the outcome of this litigation.[1] *Amici* provide their institutional affiliations for identification purposes only; they do not purport to represent the opinions or interests of their respective institutions. *Amici*'s sole interest in this case is to encourage the proper unfolding of law in their areas of specialty.

Authority to File

All parties have given permission for Pollack to file this *amicus* submission. Copies of the permission letters are attached to the proof of service submitted to the Clerk.

Summary of Argument

Amici support grant of *certiorari* without taking a position on the merits. The meaning of "work made for hire" for purposes of the 1909 Copyright Act is unsettled. The uncertainty is important because it chills, often fatally, use of many works of historical, artistic, and educational importance. The Court should discharge its responsibility for settling important issues of federal statutory construction by

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1. No party has authored this brief in whole or in part. The printing of this *amicus* filing was paid for by Malla Pollack with the generous support of the University of Idaho, College of Law.

granting a writ of certiorari in this case regardless of the Court's view of the proper meaning of the disputed phrase.

Argument

I. The Question Raises an Unsettled Issue

Does "such work is made for hire" for "an employer," Copyright Act of 1909, § 24, mean the same as "(1) [such] work [is] prepared by an employee within the scope of his or her employment," the first definition of a "work made for hire," 17 U.S.C. § 101, under the 1976 Act?[2] Under plain meaning rules of statutory construction, the answer should be "yes," absent some compelling difference in the statutory text read as a whole. The statutes have no such compelling divergence.[3] Therefore, absent this Court's issuing a

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2. The Petitioner's phrasing is "[w]hether under the Copyright Act of 1909 a commissioning party is an "employer" entitled to renew the copyright in a work for hire." Dastar Corp. v. Random House, Inc. (U.S. No. 05-1259), Petition for a Writ of Certiorari at i.

3. The second definition in the 1976 Act as amended has no counterpart in the text of the 1909 Act:
"2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by

them that the work shall be considered a work made for hire. For the purpose of the foregoing sentence, a "supplementary work" is a work prepared for publication as a secondary adjunct to a work by another author for the purpose of introducing, concluding, illustrating, explaining, revising, commenting upon, or assisting in the use of the other work, such as forewords, afterwords, pictorial illustrations, maps, charts, tables, editorial notes, musical arrangements, answer material for tests, bibliographies, appendixes, and indexes, and an "instructional text" is a literary, pictorial, or graphic work prepared for publication and with the purpose of use in systematic instructional activities.

"In determining whether any work is eligible to be considered a work made for hire under paragraph (2), neither the amendment contained in section 1011(d) of the Intellectual Property and Communications Omnibus Reform Act of 1999, as enacted by section 1000(a)(9) of Public Law 106-113, nor the deletion of the words added by that amendment--
(A) shall be considered or otherwise given any legal significance, or
(B) shall be interpreted to indicate congressional approval or disapproval of, or acquiescence in, any judicial determination, by the courts or the Copyright Office. Paragraph (2) shall be interpreted as if both section 2(a)(1) of the Work Made For Hire and Copyright Corrections Act of 2000 and section 1011(d) of the Intellectual Property and Communications Omnibus Reform Act of 1999, as enacted by section 1000(a)(9) of Public Law 106-113, were never enacted, and without regard to any inaction or awareness by

definitive ruling, the Ninth Circuit's contrary reading leaves a shadow on claims of ownership or of public domain status.

Community for Creative Non-Violence v. Reid ("CCNV"), 490 U.S. 730, 739-40 (1989), settled the construction of "(1) a work prepared by an employee within the scope of his or her employment," 17 U.S.C. § 101 (1976 Copyright Act). The opinion noted the confusion under the 1909 Act's similarly worded provision. *See CCNV*, 490 U.S. at 744 (stating that federal courts read the provision to refer "only to works made by employees in the regular course of employment"); *id.* at 749 (noting that starting in 1966 some courts "applied the work made for hire doctrine to commissioned works"). The 1909 Act's construction was not at issue in the case. *CCNV*, 490 U.S. at 732 ("To resolve this dispute, we must construe the 'work made for hire' provisions of the Copyright Act of 1976.") and the Court did not purport to explicate the 1909 Act. This judicial restraint has allowed the Ninth Circuit to dismiss the Court's logic as irrelevant to the 1909 Act because "no part of [this Court's] decision [in *CCNV*] rests on the meaning of the work-for-hire provision in the 1909 Act." Twentieth Century Fox Film Corp. v. Entertainment Distributing, 429 F.3d 869, 878 (9th Cir. 2005) (this case).

This Court's analyses, however, are never irrelevant.

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the Congress at any time of any judicial determinations.

"The terms "WTO Agreement" and "WTO member country" have the meanings given those terms in paragraphs (9) and (10), respectively, of section 2 of the Uruguay Round Agreements Act."
17 U.S.C. 101.

The logic of *CCNV*'s discussion of "employer" and "employee" are just as compelling regarding the 1909 Act as the 1976 Act. *See CCNV*, 490 U.S. at 739-41. "The starting point for [the Court's] interpretation of a statute is always its language." *Id.* at 739.

Until this Court speaks, any contrary holding remains open to question – sufficient question to undermine the certainty needed by risk-averse users of intellectual property. Unless the would-be-user of a work has the monetary muscles to stand suit, the number of lesser authorities supporting a logically exposed position affects only the level of risk, not the existence of risk.

II. Settling This Issue Is Important

Non-use of copyrighted works undermines a core purpose of both the copyright statutes and the Constitution's Copyright Clause, U.S. Const. Art. I, sec. 8, cl. 8 ("Congress shall have the power ... To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."); *see also* Eldred v. Ashcroft, 537 U.S. 186, 207 (2003) (recognizing that the "public distribution" of works is one of the main goals of both the copyright statutes and the Constitution); H.R. Rep. No. 105-452, p. 4 (1998) (supporting extension of copyright term for purpose of "provid[ing] copyright owners generally with the incentive to restore older works and further disseminate them to the public"); Marybeth Peters, Register of Copyrights, Report on

Orphan Works[4] 1 (2006) (declaring that "forestall[ing]" the "productive and beneficial use" of a work "is not in the public interest."), *available at* <http://www.copyright.gov/orphan/> .

The 1909 Act's provisions are relevant for a large number of works, those published between 1923 and 1977. Works published between 1923 and 1963 inclusive have entered the public domain unless they were properly renewed. Such renewals can be challenged if they were made under the erroneous belief that the work involved was, or was not, a work made for hire. *See* 17 U.S.C. §304; Copyright Act of 1909, 17 U.S.C. § 24 (repealed by Copyright Act of 1976); *see also* Robert A. Gorman & Jane C. Ginsburg, Copyright: Cases and Materials 360-61 (6th ed. 2002). Works published between 1964 and 1977 inclusive are still covered by copyright even if no renewal was filed, but the identity of their original copyright holder(s) is determined by the 1909 Act, including the work made for hire provisions. *See* 17 U.S.C. §304; *see also* Gorman & Ginsburg, *supra* at 360-61.

The uncertainty affects all works whose status changes depending on the scope of "works made for hire." Therefore, the problem is greater than the number of works which were registered or renewed as "works made for hire."

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4. An "orphan work" is one whose copyright owners(s) "cannot be identified and located by someone who wishes to make use of the work in a manner that requires permission of the copyright owner." Marybeth Peters, Register of Copyrights, Report on Orphan Works 1 (2006) *available at* <http://www.copyright.gov/orphan/>.

Works which might have been made for hire pursuant to the 1909 Act require unshakeable titles. Especially for older works, "[m]any users of copyrighted works have indicated that the risk of liability for copyright infringement, however remote, is enough to prompt them not to make use of the work." Peters, *supra*, at 1. The orphan work problem is both "real" and "elusive to quantify." *Id.* at 7. Works that were automatically provided "renewal" terms by the 1976 Copyright Act are especially likely to be orphan works; only fifteen percent of copyright holders considered their works sufficiently valuable to file renewals. *See* H.R. Rep. No. 94-1476, at 135 (1976).

Non-use of old works increases when frustrated would-be users lack certainty on the first link in the chain of title, for example, because of the work for hire doctrine. *See* Peters, *supra*, at 35 (listing the work for hire doctrine as one of the problems involved in "determining the status of copyright protection"). "[W]hen confronted by the absence of clear information about the work's owner, most users simply do not use the work." *Id.* at 26.

In short, the risk of error regarding the possible work for hire status of works originally published between 1923 and 1977 prevents too many beneficial uses of such works.

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Conclusion

For the reasons discussed above, this Court should grant a writ of certiorari regardless of the Court's view on the merits of petitioner's claim.

Respectfully Submitted May 24, 2006

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